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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,481	04/04/2002	Kazuhiro Takagi	AM100246-00	1417

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 06/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,481	Applicant(s) TAKAGI ET AL.	
	Examiner Neil Levy	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 10 and 13-17 is/are pending in the application.
 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 13, 14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 9, 12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Newly submitted claim 15 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim is to protection of houses articles, construction materials, while original examination was directed only to claims drawn to wood or soil

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 3 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1, 10, 13, 14, 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of record is maintained. See Sbragia; different species of Ants are differently affected by the same toxicant-solenopsis is effectively treated by a Hexaflumuron derivative, while pharaoh ants are not (col. 7); likewise with Daphnia – no effects of similar compounds differing only by replacing H with ethyl (compound 1 versus compounds 2 or 3). See also Thoms – specific termiticides of the same urea type as ~~Sbragia~~ are again shown to be widely disparate in toxicity in C. formasanus (example 1). Also, there is a 10-fold difference between R. Flavipes and C. formasanus (col. 7, line 60-67). Further, delivery form is of criticality

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(col. 8, line 1-3) and must be considered in determining acceptable forms. Also, see ~~Metel~~ ~~Metel~~ – there were over 1700 termite species, 103,000 Hymenoptera 22,000 ~~or~~ ~~6R~~ ~~Thoptera~~ in 1962. The amount of effort required to determine lethality, or some other measure of control (attract, repel), for each structural variant of formula I-1, with simultaneous testing or experimentation to determine acceptable means of delivery would be beyond the quantity of experimentation necessary to support I-1 with over 100,000 insect species. Again, applicants own work discloses, lack of general applicability, only a few compounds were 50% lethal to one Coptotermes strain, and only 2 were effective an five ants.

Applicant's arguments are that one in the art would only engage in routine experimentation. Applicant also points to such experimentation as limited to the specification, of particular compounds pest's species and amounts. However the amounts, for instance only are shown for ants (lines 15-17), at citation applicant provides (p.26, lines 18-24). Therefore we maintain the rejection as claiming more than the specification support. Claim 13, as now written, if applied to fire ants eludes this rejection.

As to 112th paragraph rejection, applicant is evidently holding to the effective amount as an amount applied to "control", not further defined ants. However, we do not see this as a limitation of the term, and will consider effective amount to be that amount to be that amount effective for any function within the operation of the claimed methods. The rejection is withdrawn.

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Claims 1, 10, 14, 16, 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Toki et al EP 0500111 or Harrison et al – WO 92/06076.

The rejection of record is maintained. Toki does provide applicant's claim 1, compound in methods to control ants and termites, and, in accord with applicants arguments that it is within the skill of one in the art to perform the minimal experimentation needed to determine if each of the variants of I1 are effective, we find Toki also obvious to that one to know to do the testing to find Tokis' compounds useful in the Toki methods to control ants and termites, likewise with Harrison.

The rejection based on Takagi is withdrawn.

Claims 1, 10, 13, 14, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Treacy et al 6342578.

Compound I1, claim of the instant invention was used to control Cockroach, ants, termites or the like (col. 7, lines 32-35, and compound I(a) (col. 8). Application is to plant (crop) foliage or insect habitat (col. 7, lines 9-12).

Applicant's arguments filed on 3/19/04 have been fully considered but they are not persuasive. Applicant's arguments were considered and rejections restyled, ~~were~~ *where* persuasive. We concur with the European Authority that the instant invention as claimed is not novel; nor do we find it non obvious. Applicants' arguments for the artisan performing known experiments to arrive at the claimed invention are applicable to finding the prior art also arrives at the claimed invention. However, we also find more on point references, Treacy.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Hess whose telephone number is 571-272-1525. The examiner can normally be reached on Monday thru Friday from 6:30 to 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Levy/LR
June 3, 2004



NEIL S. LEVY
PRIMARY EXAMINER
PRIMARY EXAMINER
NEIL S. LEVY